

Appln No. 09/765,535

Amdt date April 13, 2005

Reply to Office action of October 13, 2004

REMARKS

Claims 1 - 20 are now pending in this application. Claims 1-14, and 17-20 have been amended. Claim 16 has been cancelled. Applicant adds new claims 21-25. The amendments and new claims find full support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendments and remarks that follow, reexamination, reconsideration, and an early indication of allowance of claims 1 through 24 are respectfully requested. Applicant also submits herewith a Request for Continued Examination along with the required fee.

I. Claims Rejected Under 35 U.S.C. § 101

The Examiner rejects claims 1-13 and 17-20 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses these rejections.

Claims 1-13 and 17-20, each include elements related to database searches such as searching "a database to determine the cost of the plurality of travel products" recited in claim 1. Applicants believe this element clearly falls within the 'technical arts,' though Applicant disagrees with the Examiner's characterization of this "requirement." The Examiner argues in section 7 of the Office Action mailed October 13, 2004, that the holdings of *State Street Bank & Trust Co. v. Signature Financial*, 149 F.3d 1368, 1373-77 (Fed. Cir. 1998) and *AT&T Corp v. Excel Communications Inc.*, 172 F.3d 1352, 1356-58 (Fed. Cir. 1999), *cert denied* 120 S.Ct. 368 (1999) (applying holding of *State Street* to method claims) are inapplicable to the analysis as to whether the rejected claims meet the requirements of U.S.C. § 101, because these cases allegedly address the second part of a two prong test and assume the requirements of the

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first part ("the technical arts" requirement) are met. Applicant disagrees with the Examiner's presentation of the law as it relates to the determination of statutory subject matter. Applicant notes that neither *State Street* nor *AT&T* indicates that its holding is part of any two prong test or limited by such a test. The authorities that the Examiner relies upon for this test all predate both *State Street* and *AT&T* and therefore, do not have precedential value over these cases. The Board's decision in *Ex parte Bowman* which is cited by the Examiner, while not earlier in time is a weak authority in comparison with these cases and does not support the Examiner's position.

First, *Ex parte Bowman* is an unpublished opinion that expressly states that it is not binding precedent. Accordingly, reliance on this opinion in any way by the Examiner is improper. Further, while *Ex parte Bowman* discusses "technological arts," it does not cite any precedent applying it to a §101 patentable subject matter, does not discuss any "two-pronged" test at all and does not even cite the C.C.P.A. cases that the Examiner relies upon. Indeed, the main opinion in *Ex parte Bowman* does not even mention *State Street* or *AT&T*.

Further, *Ex parte Bowman* can be clearly distinguished from the facts of the present application. The application in *Ex parte Bowman* "carefully avoided tying the disclosed and claimed invention to any technological art or environment." See *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (BdPatApp&Int 2001). That is not the case with the present application. As noted above, the independent claims explicitly include searching a database, which is clearly tied to a 'technological art.' Thus, *Ex parte Bowman* is inapposite.

Even under the Examiner's erroneous statement of the law, the claims still fall within the 'technological arts.' The Examiner asserts that the claims at issue in *State Street* and

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AT&T meet this 'technological arts' requirement of the test. In comparison with the claims of AT&T, the independent claims of the present Application are more clearly related to the 'technological arts.' An independent claim in AT&T, which the Examiner admits meets the requirements recites:

1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

See *AT&T Corp v. Excel Communications Inc.*, at 1354. The claim elements only require generating a record for an interexchange call and including an indicator within the record. Nothing in these elements requires any use of "technological arts." Rather, each element could be performed by a human. This claim does not recite any elements that more clearly identifies it as falling within the 'technological arts' than the search of a database recited in each of the independent claims in this Application. Therefore, claims 1-13 and 17-20 meet the requirements of 35 U.S.C. § 101. Accordingly, reconsideration and withdrawal of the non-statutory subject matter rejections of these claims are requested.

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II. Claims Rejected Under 35 U.S.C. § 103(a)

The Examiner also rejects claims 1-10 and 12-20 under 35 U.S.C. §103(a) as obvious and unpatentable over U.S. Patent No. 6,360,205 issued to Iyengar et al. (herein after "Iyengar"), in further view of U.S. Patent No. 5,932,454 issued to Jafri et al. (hereinafter "Jafri").

In order to establish a *prima facie* case of obviousness, the Examiner must show that the cited references, combined, teach or suggest each element of a claim. In regard to claim 1, this claim as amended includes the elements of "a calculation step, wherein the received information is used to search through a database to determine the cost of the plurality of travel products" and "a reporting step performed after the calculation step, wherein the cost of each of the plurality of travel products is reported to the user". The cited references do not teach these elements of claim 1. Rather, Iyengar teaches calculating and reporting a single travel product at a time. See for example, Iyengar figures 21-25 and col. 15, line 15 - col. 19, line 63 discussing a flight search.

More specifically, in Iyengar, the itinerary for which the cost is calculated consists of only one travel product, such as, for example, airline flights. See Iyengar, Fig. 24. "Once a preferred flight is selected, the user is forwarded to the selected target machine to complete the booking process in step 2072." See Iyengar, col. 18, lines 53-55. Iyengar does not teach a calculating step wherein cost for a plurality of travel products, such as, for example, a flight, a hotel, and a car reservation, is calculated.

After disclosing a reservation system for airline flights, Iyengar teaches that "[o]ther applications can be implemented incorporating the principles of the present invention including

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reserving vehicles, product and service purchases and leasing of products." Iyengar, col. 22, lines 16-19. Iyengar does not teach a reservation system wherein "the user is prompted to enter desired travel product information for a plurality of travel products," and, accordingly, Iyengar does not teach "a calculation step, wherein the received information is used to search through a database to determine the cost of the plurality of travel products" as well as "a reporting step *performed after the calculation step*, wherein the cost of each of the plurality of travel products is reported to the user" (emphasis added). Thus, Iyengar does not teach or suggest each of the elements of claim 1.

The Examiner argues in that the "claims fail to recite language that would require searches for the travel products to be conducted at the same time using the same information." See section 6, of the Office Action mailed October 13, 2004. While Applicant does not agree with the Examiner's interpretation of the original claim language, claim 1, as amended clarifies, that "the calculation step" and the "reporting step" each operate on "the plurality of travel products" from the "received information." Further, the "reporting step" is "performed after the calculation step." Thus, multiple uses of the system of Iyengar does not teach or suggest the elements of claim 1, as each of the uses would only include the operation of searching for one travel product and reporting one travel product and not the reporting of "the cost of each of the plurality of travel products" to the user, as recited in claim 1. Applicant notes that these amendments are not narrowing amendments as Applicant has contended that the original claims implicitly require the amended elements.

Further, Jafri does not cure these defects of Iyengar. The Examiner has not indicated and the Applicant has not been able

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to discern any part of Jafri that teaches these elements of claim 1. Therefore, claim 1 is not obvious over Iyengar in view of Jafri. Accordingly, reconsideration and withdrawal of the obviousness rejection of this claim are requested.

Claim 2-10 depend from independent claim 1 and incorporate the limitations therein. Thus, at least for the reasons mentioned in regard to independent claim 1, these claims are not obvious over Iyengar in view of Jafri. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to claims 12, 14, and 17 these claims have been amended to include elements clarifying that "information for a plurality of travel products is used to search through a database" and "after the first calculation step... each of the plurality of travel products is reported to the user" as recited, for example, in claim 12. The other independent claims have been similarly clarified. Thus, for the reasons mentioned above in regard to claim 1, these claims are not obvious over Iyengar in view of Jafri. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

In regard to claims 13, 15, and 18-20 these claims depend from independent claims 12, 14 and 17 and incorporate the limitations therein. Thus, at least for the reasons mentioned above in regard to claims 12, 14 and 17, these claims are not obvious over Iyengar in view of Jafri. Accordingly, reconsideration and withdrawal of the obviousness rejection of these claims are requested.

The Examiner also rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over Iyengar and Jafri, in further view of U.S. Patent No. 5,948,040 issued to DeLorme et al. (hereinafter "Delorme"). Applicant respectfully traverses this rejection.

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As stated above, neither Iyengar nor Jafri teach a method for requesting information, determining costs and reporting costs for a plurality of travel products. DeLorme does not disclose these element. The Examiner has not indicated and Applicant has not discerned any part of DeLorme that teaches these elements of claim 11. Accordingly, reconsideration and withdrawal of the obviousness rejection of claim 11 are requested.

III. New Claims

It is requested that new claims 21-25 be entered. Applicant believes that the elements of these claims are not taught or suggested by the cited references and are therefore in condition for allowance.

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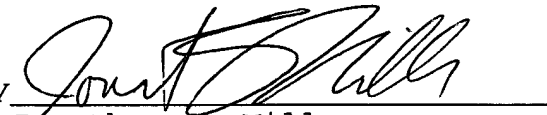
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CONCLUSION

In view of the foregoing, it is believed that all claims now pending, namely claims 1-15 and 17-25 patentably define the subject invention over the prior art of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes that a telephone conference would be useful in moving the application forward to allowance, the Examiner is encouraged to contact the undersigned at (626) 795 9900.

Respectfully submitted,
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By



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